

AMENDMENT AFTER FINAL ACTION

Appln. No. 10/713,444

Docket No. 442005-00108

REMARKS

Claims 1-17 and 21-22 are pending in the application. Claims 15 and 21-22 have been withdrawn from consideration as being drawn to non-elected species of the invention. Claims 1-14 and 16-17 stand rejected under 35 U.S.C. § 112 ¶2. Claims 1-4, 6-10, 12-14, and 16-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,644,727 to Hanson et al. ("Hanson '727") in view of an examiner's modification. Claims 1, 3, 5-6, 11, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,082,068 to Fisher ("Fisher '068").

Rejection of claims 1-14 and 16-17 under § 112 ¶2

Claims 1-14 and 16-17 stand rejected under 35 U.S.C. § 112 ¶2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. The Office alleges that the claims recite contradictory language, in that the receptacles are either at different heights or equally spaced apart heights from the bottom, while it is unclear how they can be both. Office Action mailed 9/4/2007 at p. 3.

As explained in the prior amendment, the recited receptacles must be positioned at different heights, and those different heights must be equally spaced apart heights. In the recited language "different heights, the heights being equally spaced apart heights, from the bottom of the concrete form," the phrase "the heights being equally spaced apart heights" functions as an absolute phrase, and cannot properly be read as "the heights being equally spaced apart from the bottom of the concrete form." We contend that a person of ordinary skill in the art, when reading the limitation in view of the Applicant's disclosure, particularly p. 8 ll. 3-21, would recognize that the heights 0.75 inches, 1.00 inches, 1.25 inches, and 1.25 inches, are both different heights and equally spaced apart heights, and thus understand how said heights can be both. See MPEP § 2173.02.

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In a telephone interview conducted 11/13/2007, this representative and the examiner discussed the current rejections under § 112 and reached agreement concerning the construction and presentation of the absolute phrase. At the suggestion of the examiner, claims 1 and 6 are amended to shift the absolute phrase after the language "from the bottom of the concrete form". We respectfully request entry of these amendments under 37 C.F.R. § 1.116(b)(2). The amendments present the rejected claims in better form for consideration on appeal by repositioning the absolute phrase without altering the scope or meaning of the examined claims.

Claims 6, 12, 21, and 22 have also been amended to strike the adjective "open" from subsequent references to "multiple partially enclosed receptacles" or "a plurality of partially enclosed receptacles." We respectfully request entry of these amendments under 37 C.F.R. § 1.116(b)(2). The deleted language is inherent in the introduced "partially enclosed receptacles" and therefore redundant.

Rejection of claims 1-4 and 6-10 under § 103(a) over Hanson '727

Claims 1-4 and 6-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanson '727 in view of an examiner's modification. The Office alleges that Hanson '727 discloses "[a] plurality of receptacles comprising receptacles positioned at different heights, the height[s] being equally spaced [a]part heights from the bottom of the concrete form (as best understood) (Figure 10, where element 31 is at the top of the chair and elements 12 are at the bottom)," Office Action mailed 9/4/2007 at p. 4. However, as explained above, the examiner's prior understanding misconstrued the Applicants' claims. In addition, Hanson '727 discloses a device in which the receptacles are manifestly not provided at different heights with the different heights being equally spaced apart heights.

The Office has previously alleged that although Hanson does not expressly disclose that the identified receptacles are spaced at equally spaced apart heights/distances from each other, the Applicants do not expressly disclose that the claimed feature solves a stated problem, provide

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an advantage, or is used for a particular purpose. *See* Office Action mailed 3/21/2007 at pp. 3, 4-5, and 6. However we respectfully argue that this apparently continuing rejection is improper and must be withdrawn. The Applicant has identified a deficiency in the prior art devices, application at p. 3 ll. 6-18 (as filed), and disclosed a structure which eliminates that deficiency, including multiple receptacles used for a particular and advantageous purpose, application p. 4 ll. 1-3, p. 4 l. 19 to p. 5 l. 2, p. 9 ll. 6-11 and ll. 16-22, and p. 10 ll. 11-16 (as filed). This disclosure is now acknowledged by the Office. Interview Summary mailed 11/29/2007 at p. 2.

The Office has also previously argued that the provision of equally spaced apart heights would be a matter of obvious design choice, but provided no evidence or legal authority in support of this contention. The Office may not reach factual conclusions based on its own understanding or experience, or on its assessment of what would be basic knowledge or common sense, but must point to some concrete evidence in the record in support of its findings. *In re Zurko*, 258 F.3d 1371, 1385 (Fed. Cir. 2001). The Office has provided no such evidence. Moreover MPEP 2144.04 forbids the precise argument offered by the Office. "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." MPEP § 2144.04 (citing *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984)). The Office's prior contention that such a modified device would perform, equally well, the same function as the unmodified device does not provide a logical reason for making that modification, but merely establishes that the cited reference does not teach away from the proposed modification. This is not sufficient. MPEP § 2144. Thus the Office has failed to establish a *prima facie* case for obviousness of the claimed invention, and the rejections must be withdrawn.

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Rejection of claims 12-14 and 16-17 under § 103(a) over Hanson '727

Claims 12-14 and 16-17 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanson '727 in view of an examiner's modification. The Office admits that "Hanson does not disclose that the multiple receptacles of one of said legs are positioned at different heights with respect to said multiple receptacles of the other of said legs," Office Action mailed 9/4/2007 at p. 6, but argues that "applicant has not disclosed that such a feature solves a stated problem, is used for a particular purpose or provides an advantage," *id.* The Office further argues that "it would have been an obvious matter of design choice to one of ordinary skill in the art to modify the receptacles of Hanson as both chairs would perform, equally well, the same function of supporting a reinforcement. The Applicants specification teaches otherwise. Application p. 3 ll. 6-18, p. 4 ll. 1-3, p. 4 l. 19 to p. 5 l. 2, p. 9 ll. 6-11 and ll. 16-22, and p. 10 ll. 11-16 (as filed). Moreover it is evident from the description and drawings that the use of "multiple receptacles of one of said legs are positioned at different heights with respect to said multiple receptacles of the other of said legs" can provide a more compact device than a device having a similar number of receptacles disposed along only one leg, or a symmetric device having twice the number of receptacles positioned along both of said legs. Application p. 8 ll. 12-21 and Fig. 3.

The rejections of claims 12-14 and 16-17 rely upon essentially the same arguments presented with respect to the rejection of claims 1-4 and 6-10 over Hanson '727, so that the arguments presented above are equally applicable and incorporated herein by reference. The Office has failed to establish a *prima facie* case for obviousness of the claimed invention, and the rejections must be withdrawn.

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Rejection of claims 1, 3, 5-6, and 11 under § 103(a) over Fisher '068

Claims 1, 3, 5-6, and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fisher '068. The Office alleges that Fisher '068 discloses "[a] plurality of receptacles comprising at least three receptacles positioned at different heights, the heights being equally spaced apart [heights], from [the] bottom of the concrete form (as best understood)." *Id.* However, as explained above, the examiner's prior understanding of the quoted limitation misconstrued the Applicants' claims. In addition, Fisher '068 discloses a device in which the receptacles are manifestly not provided at different heights with the different heights being equally spaced apart heights.

We respectfully note that the current rejection under § 103 over Fisher '068 fails to present any modification or modifying rationale. Office Action mailed 9/4/2007 at p. 8. The Office has previously alleged that although Fisher does not expressly disclose that the identified receptacles are spaced at equally spaced apart heights/distances from each other, the Applicants do not expressly disclose that the claimed feature solves a stated problem, provide an advantage, or is used for a particular purpose. *See* Office Action mailed 3/21/2007 at p. 10. However we respectfully argue that this apparently continuing rejection is improper and must be withdrawn for the same reasons identified above with respect to Hanson '727.

The Office has also previously argued that the provision of equally spaced apart heights would be a matter of obvious design choice, *id.*, but provided no evidence or legal authority in support of this contention. We again respectfully argue that this apparently continuing rejection is improper and must be withdrawn for the same reasons identified above with respect to Hanson '727. The Office has failed to establish a *prima facie* case for obviousness of the claimed invention, and the rejections must be withdrawn.

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Conclusion

In view of the foregoing amendments and remarks, we respectfully submit that the present claims are allowable over the art of record and pray for a prompt allowance. The Commissioner is authorized to charge any additional fees required or to credit any overpayment to Deposit Account No. 20-0809.

Respectfully submitted,

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